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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,118	04/14/2004	Haimanot Bekele	9209M	6444
27752 7590 01/28/2009 THE PROCTER & GAMBLE COMPANY Global Legal Department - IP Sycamore Building - 4th Floor 299 East Sixth Street CINCINNATI, OH 45202				
EXAMINER MAHYERA, TRISTAN J				
ART UNIT		PAPER NUMBER		
1615				
MAIL DATE		DELIVERY MODE		
01/28/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,118

Applicant(s)

BEKELE ET AL.

Examiner

TRISTAN J. MAHYERA

Art Unit

1615

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 12-16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12-16, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/17/2008 has been entered.

Status of Claims

Claims 1-6, 12-16 and 18-23 are pending. Claims 18-21 were previously withdrawn as being drawn to the non-elected invention. Claims 7 and 17 were previously cancelled. Claims 8-11 and 24 have been cancelled. Claims 1-6, 12-16, 22 and 23 are examined on the merits.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 12-16, 22 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims were amended to add "...wherein the ratio of (1) to (3) is at least 1:1,...". According to the Examples, which again give specific combinations of modified silicones and polydimethylsiloxane (ratios derived from 9.5% and 0.5% in Ex. 3, 10% and 8% in Ex. 2, and 10% and 10% in Ex. 1), but nothing to support "at least 1:1", just ratios of 1:1 (Ex. 1), 1.25:1(Ex. 2) and 19:1(Ex. 1). This is a new matter rejection.

Claim Rejections - 35 USC § 103

The statutes and rules under this section can be found in a prior office action.

Claims 1-6, 12-16, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over DRECHSLER (US 6,139,823, see PTO-1449 dated 12/10/2004) in view of GAWTREY et al (US 2003/0157049 see PTO-892).

DRECHSLER teaches a cosmetic composition comprising an organosiloxane resin, a polydiorganosiloxane polymer and a volatile carrier. See e.g. col 1 lines 15-17; instant claim 1. Modified silicones, specifically aminosilicones, i.e. the amino alkyl side of silicone are used in the cosmetic composition as a derivative of the polydiorganosiloxane. See e.g. claim 6 (amino alkyl side of silicone); instant claim 1.

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The use of an organosiloxane resin is exemplified in claim 1 line 7; instant claim 1. A volatile carrier is taught in claim 1 line 12. The volatile carrier is selected from the group consisting of hydrocarbon oils, silicone oils and mixtures thereof. See e.g. claim 17; instant claim 14. The volatile carrier is specifically isododecane. See e.g. claim 18; instant claim 15. Example 6 is anhydrous, as no water is used. See example 6, col 19; instant claim 1. Examples of thickeners used are propylene carbonate and bentonite clay. See e.g. example 29 col 34 line 66 to col 35 line 1; example 29 col 34 line 48; instant claims 2, 3 and 4. The organosiloxane resin comprises $R_3SiO_{1/2}$ "M" units, $R_2SiO_{1/2}$ "D" units, $RSiO_{3/2}$ "T" units and SiO_2 "Q" units, to satisfy the relationship $R_nSiO_{(4-n)/2}$ where n is from about 1.0 to about 1.50 and R is a methyl group. See e.g. claim 3; instant claim 5. The organosiloxane resin also comprises $R_3SiO_{1/2}$ "M" units and SiO_2 "Q" units, wherein the ratio of $R_3SiO_{1/2}$ to SiO_2 is about 0.7. See e.g. claim 7; instant claim 6. The use of the term "about" in the instant invention broadens the range of the ratio and is anticipated by the about 0.6 of the prior art. The diorganopolysiloxane polymer is polydimethyl siloxane. See e.g. claim 8; instant claims 1 and 8-11. The modified silicone has a viscosity of from about 100 cSt to about 2,000,000 cSt at 25 degrees C. See e.g. claim 11 line 4; instant claims 12 and 13. A topcoat is added over the composition as a complementary product, which can be any commercially available or developed product that increases the shine, gloss or lubricious nature of the lips. See e.g. col 10 lines 48-65; instant claim 1. A kit is simply a combination of products, thus the complementary topcoat product of the reference, which is taught as a product in addition to the main invention reads on the kit.

Claim 16 recites the composition of claim 1 as having a viscosity from about 500 cP to about 15,000 cP. While this is not specifically stated in the prior art the properties of the composition recited by Applicants are reasonably deemed to be present in the composition suggested by the prior art, because the components are the same. It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter in which there is reason to believe inherently includes functions that are newly cited or are identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

DRECHSLER does not explicitly teach the teach a separate modified silicone selected from aminosilicones, carboxy modified silicones, epoxy modified silicones and mixtures thereof having a ratio of at least 1:1 with the polydiorganopolysiloxane.

GAWTREY et al. teaches the use of both aminosilicones and separate and distinct polyorganosiloxanes, specifically a polydimethylsiloxane together in a cosmetic composition. See e.g. claim 1 and claims 38, 51-53: instant claims 1, 22 and 23. The compositions of GAWTREY in one embodiment are used on the lips. See e.g. p[0504]. The conditioner (polyorganosiloxanes) are present from 0.001% to 20% by weight. See e.g. p[0421]. The aminosilicones are present from 0..1% to 20% by weight, which taken in combination with the polyorganosiloxanes, reads on ratios of at least 1:1. See e.g. p[0056]: instant claims 1, 22 and 23. The conditioner (polyorganosiloxanes) affords at least one improved cosmetic property such as sheen. See e.g. Abstract.

It would have been prima facie obvious to a person of ordinary skill in the art at the time the invention was made to make a composition comprising aminosilicones, an organosiloxane resin and a polydiorganopolysiloxane, as taught by DRECHSLER in view of GAWTREY. One of ordinary skill in the art at the time the invention was made would have been motivated to combine these elements into a single composition because of the beneficial effects of a aminosilicone and polydiorganopolysiloxane combination for the lips that improves at least sheen, as taught by GAWTREY. Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention.

Claims 1, 22 and 23 recite a topcoat composition, however this is a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the teachings of DRECHSLER make clear that any product that increases the shine, gloss or lubricious nature of the lips can be used as a topcoat. See e.g. col. 10 lines 48-65. The composition of GAWTREY increases sheen (i.e. shine or luster) and thus would be an excellent topcoat. See e.g. Abstract of GAWTREY.

Response to Arguments

Applicant's arguments filed on 11/17/2008 have been fully considered yet are not found persuasive. As NICHOLS is not relied on in this Office Action, only arguments related to DRECHSLER are addressed.

Applicants' argue that DRECHSLER does not teach or suggest it is within the skill of the art to improve the luster or smear resistance of lip compositions since only claim 6 is referenced. The Examiner agrees that smear resistance was taught by NICHOLS, however, DRECHSLER does specifically teach the use of a topcoat which is added or applied over the composition as a complementary product and can be any commercially available or developed product that increases the shine, gloss or lubricious nature of the lips – all of which improve or are synonyms for luster. See e.g. col. 10 lines 48-65; instant claim 1. When in combination with GAWTREY, an ordinary person skilled in the art would have been taught that the specific aminosilicones and polydimethylsiloxanes of GAWTREY increases sheen (i.e. shine or luster) and thus would be an excellent topcoat as stated in DRECHSLER. Therefore, DRECHSLER does teach the use of a topcoat that improves shine or luster.

Applicants' further argue that the instant invention requires both polydiorganopolysiloxane and amino-, carboxy-, or epoxy- modified silicones -resulting in a blend of two differently functionalized silicones- whereas DRECHSLER does not teach or suggest the two components together. Further, Applicants' state that the invention requires a ratio of modified silicones to polydiorganopolysiloxane of at least

1:1. The Examiner reads DRECHSLER as teaching both the polydiorganopolysiloxane and amino-, modified silicones together, as can be found in claim 6, which explicitly states "mixtures thereof" thereby allowing for an amino alkyl modified silicone and another non modified polydiorganopolysiloxane. The amendment to the instant claims adds the ratio of 1:1 limitation, which is not taught in DRECHSLER and thus GAWTREY is relied on for both the ratio and thus a specific demarcation between the polydiorganopolysiloxane and the modified silicones.

Conclusion

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRISTAN J. MAHYERA whose telephone number is 571-270-1562. The examiner can normally be reached on Monday through Friday 9am-7pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL P. WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tristan J Mahyera/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615